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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/758,018	01/16/2004	Jean-Bruno Danczin	P24744	5754

7055 7590 06/08/2006

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EXAMINER

PATTERSON, MARIE D

ART UNIT	PAPER NUMBER
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3728

DATE MAILED: 06/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/758,018	DANEZIN ET AL.	
	Examiner	Art Unit	
	Marie Patterson	3728	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 April 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2. Claims 5, 6, 13, and 18 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Polifroni (6817115) or (2003/0061739).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-4, 11, 12, 14, and 19-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Polifroni.

Polifroni shows a innersole (10) with recesses (42 and 44) for anti-slip inserts (48 and 49) and teaches the use of "any suitable slip resistant material" (column 4 line 50) for the inserts. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use abrasive paper, abrasive amalgam, etc., since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416.

5. Claims 7, 10, 15-17, and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bonaventure (5228218) in view of either Polifroni or Bauerfeind (5438768).

Bonaventure shows a ski boot which is conventionally made from rigid plastics (2), a removable liner (11) with a removable innersole (14) substantially as claimed except for antislip insert between the innersole and liner. Either Polifroni or Bauerfeind teaches providing an antislip inserts (48 and 49 or 18) on the lower surfaces of removable innersoles. It would have been obvious to provide anti slip inserts as taught by either Polifroni or Bauerfeind on the innersole of Bonaventure to prevent the innersole from slipping during wear.

6. Claims 8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claims 7 and 10 above, and further in view of Marega (4920666).

Bonaventure as modified above shows a boot substantially as claimed except for providing an outersole on the liner. Marega teaches providing an outersole (33) on a

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removable liner. It would have been obvious to provide an outersole on the liner as taught by Marega in the boot of Bonaventure as modified above to prevent slipping of the innerboot, increase the durability of the innerboot, etc..

Claim Rejections - 35 USC § 112

7. Claims 11, 13, 15, and 18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 11, 13, 15, and 18 the phrase “provides an abrasive anti-slip feature for the inner sole only upon a certain downward pressure being exerted on the inner sole” is confusing, vague, and indefinite because it is not clear what structural limitations applicant intends to encompass with such language. There is no guidance in the specification as to what such language would encompass and the sand paper disclosed is not considered to have such a property.

Response to Arguments

8. Applicant's arguments filed 4/14/06 have been fully considered but they are not persuasive.

In response to applicants' arguments directed towards Polifroni, the inserts of Polifroni are considered to be “abrasive” inasmuch as the term “abrasive” is defined as “a substance which abrades” and “abrade” is defined as “to rub or wear away especially by rubbing....to irritate or roughen by rubbing” (Merriam-Webster OnLine). The material taught by Polifroni, i.e. rubber or any suitable slip resistant material (column 4 line 50) is

considered "abrasive". Rubber clearly would rub, roughen, and wear away a cloth top layer of a sole over a period of time.

In response to applicant's arguments directed towards the concerns of the prior art versus the concerns of applicant, both are concerned with preventing the insole from slipping relative to the top layer of the sole.

In response to applicants' argument that sand paper only prevents slipping when pressure is applied, the Examiner does not agree, sand paper would prevent slipping even without pressure on the paper. The prior art is considered to prevent slipping when pressure is applied inasmuch as applicants' sand paper is considered to do such. Claims in a pending application should be given their broadest reasonable interpretation. In re Pearson, 181 USPQ 641 (CCPA 1974).

In response to applicants' argument directed towards the combination of Bonaventure (5228218) in view of either Polifroni or Bauerfeind (5438768), the use of rigid orthotics in all and any footwear for correcting foot maladies is well known and extremely common. The type of orthotic is dependent on the patients needs and comfort desired and is a personal choice decided by the patient and caregiver.

In response to applicants' arguments directed towards Baurefeind, Baurefeind teaches providing an antislip insert (18) which prevents the insole from slipping.

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP


§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

1. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). Other useful information can be obtained at the PTO Home Page at www.uspto.gov.

In order to avoid potential delays, Technology Center 3700 is encouraging FAXing of responses to Office Actions directly into the Center at **(572)272-8300 (FORMAL FAXES ONLY)**. Please identify Examiner Marie Patterson of Art Unit 3728 at the top of your cover sheet.

Any inquiry concerning the MERITS of this examination from the examiner should be directed to Marie Patterson whose telephone number is (571) 272-4559. The examiner can normally be reached from 6AM - 4PM Mon-Wed.


Marie Patterson
Primary Examiner
Art Unit 3728